

REMARKS

Claims 1-20 were pending in the present Application. Claims 1-10 and 18-20 have been canceled, and Claims 11, 14, 15 have been amended, leaving Claims 11-17 for further consideration upon entry of the present Amendment.

No new matter has been introduced by these amendments. Support for the amendments is found throughout the Specification beginning at least at page 5, paragraph [20] and the claims as originally filed. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-3 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent 5,053,930 to Benavides (“Benavides”). Claims 1-3 and 8-10 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent 4,401,050 to Britt et al. (“Britt”), as stated by the Examiner in a telephone communication on January 13, 2006. Applicants respectfully traverse the rejection.

The rejection has been rendered moot in view of the cancellation of Claims 1-3 and 8-10.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 4-7, 11-17 and 18-20 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Patent 5,053,930 to Benavides (“Benavides”). Applicants respectfully traverse this rejection.

Benavides is generally directed to a phosphorescent vehicle part identification accessory including a phosphorescent article or molding. The phosphorescent article or molding include are vehicle side moldings, valve stem caps and keyhole protective shields that may be affixed around a keyhole. There is no disclosure or suggestion of applying the

article or molding to a vehicle roof assembly.

As amended, Claim 11 recites a self-illuminating roof assembly comprising a roof wall having an interior surface and an exterior surface and an interior panel secured to the interior surface of the roof wall, the interior panel being comprised of a phosphorescent material and a polymer matrix.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicants respectfully assert that a *prima facie* case of obviousness has not been established against Claims 11-17. A *prima facie* case of obviousness has not been established because there is no disclosure or suggestion of a self-illuminating roof assembly as in Claim 11.

With regard to independent Claim 11, the Examiner has acknowledged that Benavides does not teach or suggest a roof assembly comprising, *inter alia*, a roof wall extending between an interior and an exterior portion of a vehicle, and a polymer matrix with a phosphorescent material disposed on the roof wall. (10/18/05 Office Action, p. 4, line 20, bridge to p.5, line 1.) However, it is the Examiner's assertion that since Benavides discloses a sunroof and a plastic molded part with a phosphorescent material positioned inside the vehicle, it would have been obvious to place the molded plastic part on the sunroof. (10/18/06 Office Action, p. 5, lines 2-10.) Applicants respectfully disagree.

In Benavides, the sunroof and/or convertible top is described as conduit for providing light into the interior of the vehicle so as to “charge” the phosphorescent articles disposed therein.

...[a] rear window and a side window through which light from other sources can illuminate the inside of the vehicle. The top of the vehicle will be, in many instance, constructed with a sunroof and/or a convertible top so that light can likewise be cast therein, particularly from overhead streetlights and from the sun during the day. The front windshield is likewise shown behind the hood over which light will be received from on-coming vehicle.

(Benavides, Col. 4, ll., 39-47)

Benavides further discloses that opening the door exposes the inside of the vehicle to light for illumination of the phosphorescent gearshift. (Col. 4, lines 49-51; Claim 1) In essence, Benavides discloses the sunroof as a means for providing light energy to the phosphorescent article or molding accessory, such as a gear shift. The present claims are directed to a self-illuminating roof assembly that illuminates the interior of a vehicle, not merely a system to enhance visibility of an accessory. Moreover, if one of skill in the art were to modify the sunroof as suggested by the Examiner, the intended purpose of Benavides would be defeated. That is, a roof assembly having the phosphorescent interior panel attached thereto would prevent light energy from entering the interior cabin, thereby preventing light energy from being transmitted through the sunroof to the phosphorescent article contained therein.

Further, the Examiner’s statement that one skilled in the art would place a molded part onto a sunroof misconstrues and over-extends the teachings of Benavides. The Examiner’s proposal may actually impede the operation of a sunroof designed to be opened and closed. Again, the Examiner’s proposal would not be suitable for the intended purpose and one skilled in the art would not have a reasonable expectation of success for such a modification.

Even if the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such a modification. *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). Absent in Benavides is any teaching or suggestion to seek the modification proposed by the Examiner.

Likewise, nothing in Benavides teaches or suggests a self-illuminating roof assembly having a phosphorescent material configured either to form a pattern on or in the polymer matrix or to provide a glow light discharge with a particular hue as claimed in amended dependent Claims 14 and 15.

In view of the foregoing, it is requested that the rejection be withdrawn and the claims allowed.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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